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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/762,240

01/23/2004

Mark T. Kirsch

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EXAMINER

PHAM, MINH CHAU THI

ART UNIT

PAPER NUMBER

1724

MAIL DATE

DELIVERY MODE

06/19/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/762,240	<b>Applicant(s)</b> KIRSCH, MARK T.	
	<b>Examiner</b> Minh-Chau T. Pham	<b>Art Unit</b> 1724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 5/29/07 & 6/1/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 26-29 and 34-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-29 and 34-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/1 &amp; 5/29/07</u> | 6) <input type="checkbox"/> Other: _____  |

After thoroughly considering the Remarks filed on May 29, 2007 and the IDS filed on June 1, 2007, the finality of this instant patent application is hereby withdrawn, and the prosecution is re-opened for the case.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26-29 and 34-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers (3,397,518), in view of Finerman et al (6,288,171 B2).

Rogers discloses a filter element (5) having a side portion, a corner portion, 6 side portions, and a seal (4) of solid resilient thermoplastic (PVC being thermoplastic) (see col. 2, lines 54-56, col. 4, lines 45-47) disposed at corner sections and having bendable contact portion (8) extending from the face portion and formed of solid resilient material (4). It is immaterial how such is made such by injection molding if the resulting product structure is the same. Rogers further discloses a bendable portion having anchor portions and free engaging portions (see Fig. 21). Claims 27-32 differ from the disclosure of Rogers in that the seal being thermoplastic vulcanized particles (TPV) embedded in ethylene-polyene terpolymer rubber (EPDM). Finerman et al disclose thermoplastic vulcanizates (TPV) as a gasket or seal (see col. 10, lines 14-16) embedded in ethylene-polyene terpolymer rubber (EPDM) (see col. 1, line 61 through col. 2, line 2). It would have been obvious to a person having ordinary skill in the art at

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the time the invention was made to adopt thermoplastic (TPV) embedded in ethylene-polyene terpolymer rubber (EPDM) as taught by Finerman et al for the seal of the filter element of Rogers since it is well known in the art that these rubber particles are crosslinked to promote elasticity, as such TPV exhibits the processing properties of the plastic and the elasticity of the rubber.

Regarding to the seal having various structural configurations such as having a rim portion (claims 27 & 49), a flange portion (claims 28 and 60-63), a flexible portion (claims 39, 42, 43, 52 & 53), it would have been obvious to a person having ordinary skill in the art at the time the invention was made to manufacture the seal in any various structural configurations according to different applications as needed since it is well settled that mere change of shape without affecting the function of the part would have been an obvious design modification. See Eskimo Pie Corp v. Levous et al 2 USPQ 23.

### ***Double Patenting***

Claims 26-29 and 34-63 of this application conflict with claims 27-39 of Application No. 10/404,109. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

### ***Response to Amendment***

Applicant's arguments filed on May 29, 2007 have been fully considered but they are not persuasive.

Applicant argues that the cited prior art "Coffey et al does not disclose a rigid frame extending away from the filter and is bonded to the perimeter". The Examiner now drops Coffey et al and newly introduces Rogers as the primary reference to show: A filter element (5) having a side portion, a corner portion, 6 side portions, and a seal (4) of solid resilient thermoplastic (PVC being thermoplastic) (see col. 2, lines 54-56, col. 4, lines 45-47) disposed at corner sections and having bendable contact portion (8) extending from the face portion and formed of solid resilient material (4), as claimed. It is immaterial how such is made such by injection molding if the resulting product structure is the same. Rogers further discloses a bendable portion having anchor portions and free engaging portions (see Fig. 21), as claimed.

The Examiner also newly introduces Finerman et al as the secondary reference in combination with Rogers under the 103(a) rejection of claims 26-29 and 34-63 to show: Finerman et al disclose thermoplastic vulcanizates (TPV) as a gasket or seal (see col. 10, lines 14-16) embedded in ethylene-polyene terpolymer rubber (EPDM) (see col. 1, line 61 through col. 2, line 2). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to adopt thermoplastic (TPV) embedded in ethylene-polyene terpolymer rubber (EPDM) as taught by Finerman et al for the seal of the filter element of Rogers since it is well known in the art that these rubber particles are crosslinked to promote elasticity, as such TPV exhibits the processing properties of the plastic and the elasticity of the rubber.

Regarding to the seal having various structural configurations such as having a rim portion (claims 27 & 49), a flange portion (claims 28 and 60-63), a flexible portion (claims 39, 42, 43, 52 & 53), it would have been obvious to a person having ordinary skill in the art at the time the invention was made to manufacture the seal in any various structural configurations according to different applications as needed since it is well settled that mere change of shape without affecting the function of the part would have been an obvious design modification. See Eskimo Pie Corp v. Levous et al 2 USPQ 23.

The Examiner notes that claims 26-29 and 34-63 of this application conflict with claims 27-39 of Application No. 10/404,109. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Applicant's arguments with respect to claims 26-29 and 34-63 have been thoroughly considered but are moot in view of the new ground(s) of rejection, as discussed above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh-Chau T. Pham whose telephone number is (571) 272-1163. The examiner can normally be reached on Mon/Tues/Thur/Fri 7:00 am - 5:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**Minh-Chau Pham**  
**Patent Examiner**  
**Art Unit: 1724**  
**June 12, 2007**